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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/814,441

03/22/2001

Douglas D. Calaway

4830-3 (AMK)

4595

23117

7590

01/23/2010

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EXAMINER

SMITH, JEFFREY A

ART UNIT

PAPER NUMBER

3625

MAIL DATE

DELIVERY MODE

01/23/2010

PAPER

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1 UNITED STATES PATENT AND TRADEMARK OFFICE

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3  
4 BEFORE THE BOARD OF PATENT APPEALS  
5 AND INTERFERENCES  
6

7  
8 *Ex parte* DOUGLAS D. CALAWAY, JASON R. KOTTE, and WYNN  
9 MILLER  
10

11  
12 Appeal 2009-000735  
13 Application 09/814,441  
14 Technology Center 3600  
15

16  
17 Decided: January 25, 2010  
18  
19

20 Before MURRIEL E. CRAWFORD, HUBERT C. LORIN, and ANTON W.  
21 FETTING, *Administrative Patent Judges*.  
22 FETTING, *Administrative Patent Judge*.

23 DECISION ON APPEAL

1 STATEMENT OF THE CASE

2 Douglas D. Calaway, Jason R. Kotte, and Wynn Miller (Appellants)  
3 seek review under 35 U.S.C. § 134 (2002) of a final rejection of claims 1-7,  
4 9-13, 15, 18-25, 27, and 29-33, the only claims pending in the application on  
5 appeal.

6 We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b)  
7 (2002).

8 SUMMARY OF DECISION<sup>1</sup>

9 We AFFIRM.

10 THE INVENTION

11 The Appellants invented a way of viewing and selecting images from a  
12 storage medium, and purchasing products depicted on a storage medium.  
13 Specification 1: Field of the Invention.

14 An understanding of the invention can be derived from a reading of  
15 exemplary claim 1, which is reproduced below [bracketed matter and some  
16 paragraphing added].

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<sup>1</sup> Our decision will make reference to the Appellants' App. Brief ("App. Br.," filed February 19, 2008) and Reply Brief ("Reply Br.," filed May 27, 2008), and the Examiner's Answer ("Ans.," mailed April 4, 2008).

1 1. A method for electronically initiating a purchase of an item  
2 using a computer, the method comprising the steps of:

3 [1] providing a data storage medium having at least one image  
4 of at least one item stored thereon;

5 [2] accessing an image of an item from the storage medium;  
6 viewing the accessed item image on a display in  
7 communication with a local processor;

8 [3] electronically selecting the item for purchase,  
9 causing purchase data on the item to be stored on a  
10 writable memory device in communication with the local  
11 processor,  
12 wherein all purchase data not supplied by a consumer is  
13 supplied by the data storage medium  
14 such that the purchase data is compiled entirely  
15 without Internet access,  
16 the purchase data being sufficient to complete the  
17 purchase of the item;

18 [4] permitting a first selection and a second selection,  
19 [4a] wherein the first selection causes printing of an order  
20 form containing the purchase data and configured to  
21 initiate a purchase when physically delivered to a vendor,  
22 and  
23 [4b] wherein the second selection causes storing of the  
24 purchase data on a device accessible by the local  
25 processor; and

26 [5] initiating and completing the purchase of the item without  
27 accessing the Internet.

## THE REJECTIONS

The Examiner relies upon the following prior art:

Bernard	US 5,918,213	Jun. 29, 1999
Kenney	US 6,026,376	Feb. 15, 2000

Cambridge US 2001/0037373 A1 Nov. 1, 2001  
Moneymaker US 2002/0026374 A1 Feb. 28, 2002

1 Claims 1-4, 7, 9-13, 15, 18-25, 27, 30, and 32 stand rejected under 35  
2 U.S.C. § 103(a) as unpatentable over Cambridge and Moneymaker.

3 Claims 5 and 6 stand rejected under 35 U.S.C. § 103(a) as unpatentable  
4 over Cambridge, Moneymaker, and Kenney.

5 Claims 29, 31, and 33 stand rejected under 35 U.S.C. § 103(a) as  
6 unpatentable over Cambridge, Moneymaker, and Bernard.

7 ARGUMENTS

8 The Appellants argue these claims as a group. Accordingly, we select  
9 claim 1 as representative of the group. 37 C.F.R. § 41.37(c)(1)(vii) (2008).

10 The only argument goes to limitation [5] of initiating and completing the  
11 purchase of the item without accessing the Internet. The Appellants contend  
12 that even though Moneymaker refers to an offline payment, Moneymaker's  
13 system is not operable without online access. App. Br. 16; Reply Br. 2.

14 The Examiner concluded that it would have been obvious to have  
15 modified Cambridge to complete its purchase without accessing the Internet  
16 in order to eliminate mistakes and delays associated with transmitting credit  
17 card and/or EFT data. Ans. 5.

18 ISSUES

19 The issue of whether the Appellants have sustained their burden of  
20 showing that the Examiner erred in rejecting claims 1-4, 7, 9-13, 15, 18-25,  
21 27, 30, and 32 under 35 U.S.C. § 103(a) as unpatentable over Cambridge

1 and Moneymaker turns on whether it was predictable to operate  
2 Cambridge's purchasing system without accessing the Internet.

3 The issues of whether the Appellants have sustained their burden of  
4 showing that the Examiner erred in rejecting claims 5 and 6 under 35 U.S.C.  
5 § 103(a) as unpatentable over Cambridge, Moneymaker, and Kenney and in  
6 rejecting claims 29, 31, and 33 under 35 U.S.C. § 103(a) as unpatentable  
7 over Cambridge, Moneymaker, and Bernard turns on the resolution of the  
8 first issue.

### 9 FACTS PERTINENT TO THE ISSUES

10 The following enumerated Findings of Fact (FF) are believed to be  
11 supported by a preponderance of the evidence.

#### 12 *Facts Related to the Prior Art*

##### 13 *Cambridge*

14 01. Cambridge is directed to simulating a presentation of a web  
15 page. Cambridge ¶ 0007.

16 02. Cambridge uses a computer network that may be any Internet,  
17 or alternatively any Intranet, Local Area Network (LAN),  
18 Metropolitan Area Network (MAN), Wide Area Network (WAN),  
19 Virtual Private Network (VPN), wireless network or any other  
20 suitable computer network. Cambridge ¶ 0038.

##### 21 *Moneymaker*

22 03. Moneymaker is directed to commercial transactions occurring  
23 via electronic networks such as local area networks, wireless

1 networks, intranets and the Internet environment. Moneymaker ¶  
2 0003.

3 04. Moneymaker describes an implementation in which payment is  
4 made offline. Moneymaker ¶ 0028.

5 *Facts Related To Secondary Considerations*

6 05. There is no evidence on record of secondary considerations of  
7 non-obviousness for our consideration.  
8

9 PRINCIPLES OF LAW

10 *Obviousness*

11 A claimed invention is unpatentable if the differences between it and  
12 the prior art are “such that the subject matter as a whole would have been  
13 obvious at the time the invention was made to a person having ordinary skill  
14 in the art.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007); *Graham*  
15 *v. John Deere Co.*, 383 U.S. 1, 13-14 (1966).

16 In *Graham*, the Court held that that the obviousness analysis is  
17 bottomed on several basic factual inquiries: “[1] the scope and content of  
18 the prior art are to be determined; [(2)] differences between the prior art and  
19 the claims at issue are to be ascertained; and [(3)] the level of ordinary skill  
20 in the pertinent art resolved.” *Graham*, 383 U.S. at 17. *See also KSR*, 550  
21 U.S. at 406. “The combination of familiar elements according to known  
22 methods is likely to be obvious when it does no more than yield predictable  
23 results.” *KSR*, 550 U.S. at 416.  
24

ANALYSIS

*Claims 1-4, 7, 9-13, 15, 18-25, 27, 30, and 32 rejected under 35 U.S.C.*

*§ 103(a) as unpatentable over Cambridge and Moneymaker.*

The sole issue before us is whether it was predictable from the references to implement a purchasing system as in Cambridge without accessing the Internet. None of the remaining limitations are under contention. The Appellants' argument is that there is insufficient suggestion from the art to show this would have been done.

Clearly, the Internet is simply one among many alternative communication channels. The technology for a purchasing system is largely independent of the channel employed and many alternative channels are generally easier to implement. All commercially usable channels are within the range of ordinary skill in the art. Therefore the issue reduces to whether one of ordinary skill would have found it predictable to use any one of the channels other than the Internet.

The Appellants' argument is that both references require the user to be online. App. Br. 16. This argument is simply not commensurate with the scope of the claim, which specifically recites the system not accessing the Internet per se. We take the Examiner's findings to mean that one of ordinary skill would have considered alternative less complex communication channels.

Both references support this finding as both references explicitly recite alternative channels to the Internet as falling within the scope of their disclosures. FF 02-03. Given that both references explicitly provide for alternative channels to the Internet and that the use of such channels was



1 within the range of ordinary skill in the art, we conclude it was predictable to  
2 practice Cambridge's purchasing system without accessing the Internet.

3 *Claims 5 and 6 rejected under 35 U.S.C. § 103(a) as unpatentable over*  
4 *Cambridge, Moneymaker, and Kenney.*

5 *Claims 29, 31, and 33 rejected under 35 U.S.C. § 103(a) as unpatentable*  
6 *over Cambridge, Moneymaker, and Bernard.*

7 The Appellants rely on their arguments in support of the independent  
8 claims to support the patentability of these claims.

#### 9 CONCLUSIONS OF LAW

10 The Appellants have not sustained their burden of showing that the  
11 Examiner erred in rejecting claims 1-4, 7, 9-13, 15, 18-25, 27, 30, and 32  
12 under 35 U.S.C. § 103(a) as unpatentable over Cambridge and Moneymaker.

13 The Appellants have not sustained their burden of showing that the  
14 Examiner erred in rejecting claims 5 and 6 under 35 U.S.C. § 103(a) as  
15 unpatentable over Cambridge, Moneymaker, and Kenney.

16 The Appellants have not sustained their burden of showing that the  
17 Examiner erred in rejecting claims 29, 31, and 33 under 35 U.S.C. § 103(a)  
18 as unpatentable over Cambridge, Moneymaker, and Bernard.

#### 19 DECISION

20 To summarize, our decision is as follows.

- 21 • The rejection of claims 1-4, 7, 9-13, 15, 18-25, 27, 30, and 32 under  
22 35 U.S.C. § 103(a) as unpatentable over Cambridge and Moneymaker  
23 is sustained.

- 1       • The rejection of claims 5 and 6 under 35 U.S.C. § 103(a) as  
2       unpatentable over Cambridge, Moneymaker, and Kenney is sustained.
- 3       • The rejection of claims 29, 31, and 33 under 35 U.S.C. § 103(a) as  
4       unpatentable over Cambridge, Moneymaker, and Bernard is sustained.

5 No time period for taking any subsequent action in connection with this  
6 appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

7

8 AFFIRMED

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12

13 mev

14

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